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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/242,226 | 02/10/1999 | Zhong Stella Wu | 50103-148 | 4421 |

7590

03/03/2003

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EXAMINER

RESAN, STEVAN A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1773

DATE MAILED: 03/03/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/242,226

Applicant(s)

WU ET AL.

Examiner

Stevan A. Resan

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1773

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-5, 10-14, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuya et al US 4925738.

See Fig 1, examples, Col 4 lines 35-40.

It has been held that where claimed and prior art products are identical or substantially identical in structure or in composition, or are produced by identical or substantially identical processes a case of anticipation or a prima facie case of obviousness has been established and the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess the characteristic of a claimed product whether the rejection is based upon "inherency" under 35 USC 102 or on "prima facie obviousness" under 35 USC 103 jointly or alternately.

In re Best 562 F2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977); In re Ludke, 58 CCPA 1159, 441 F.2d at 212-13, 169 USPQ 563 (1971); In re Brown, 59 CCPA 1036, 459 F.2d 531, 173 USPQ 685 (1972). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". In re Spada. 911 F2d 705, 709, 15 USPQ 2d 1655 (Fed. Cir. 1990)

Art Unit: 1773

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6,7,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuya et al as applied to claims 1 and 11 above. Tsuya et al do not disclose an Aluminum alloy thickness of 50-5000 Angstroms. However in the example the thickness is 10,000 Angstroms. It would have been obvious to one of ordinary skill in the art to optimize the thickness for the pore depth in order to minimize anodization time; the pores having claimed depths of 50- 10,000 angstroms.

5. Claims 2, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuya et al as applied to claims 1 and 11 above in view of Baumgart et al US 5586040.

Tsuya et al do not disclose a laser textured landing zone. However Baumgart et al teaches a laser texturing of a landing zone. Therefore it would have been obvious to one of ordinary skill in the art to provide a laser textured CSS zone in order to improve CSS properties by forming a more pronounced texture as taught by Baumgardt et al..

6. Claims 8,9,19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuya et al as applied to claims 1 and 11 above in view of Lai et al and the state of the art as evidenced by the Background in Lambeth et al cited below.

Art Unit: 1773

Tsuya et al do not disclose the specific layer structure as claimed. However it would have been obvious to one of ordinary skill in the art to use the structure of Lai et al in order to increase coercivity, SNR, and recording density.


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kamigaki et al, Yoshida et al and Kawai et al are cited for teachings of the sizes of anodized aluminum pores.

Valayil et al US 4525759 is cited for teaching the recognition in the art a plated metal deposited on an anodized surface has a vertical crystal structure corresponding to the oxide island on the anodized surface. Col 3 lines 45-51.

Lambeth et al US 6248416 is cited for setting forth the state of the prior art at the time of the invention in the "BACKGROUND OF THE INVENTION" See specifically Col 2 lines 36-40, 51-53, 59-63; Col 3 lines 45-64; Col 4 lines 10-44; Col 5 lines 5-12.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is (703) 308-4287. The examiner can normally be reached on Tues-Fri from 7:30AM to 6:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) *308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718


STEVAN A. RESAN
PRIMARY EXAMINER